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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,876	12/16/2003	Tohru Nishioka	1614.1374	5445

21171 7590 07/12/2006

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EXAMINER

UNELUS, ERNEST

ART UNIT PAPER NUMBER

2187

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/735,876	<b>Applicant(s)</b> NISHIOKA ET AL.	
	<b>Examiner</b> Ernest Unelus	<b>Art Unit</b> 2181	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 16 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

*Fritz Fleming*  
**FRITZ FLEMING**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**

7/7/06

#### Attachment(s)

- |  |  |
|--|--|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br/>Paper No(s)/Mail Date <u>12/16/03, 11/22/05</u> <i>01/25/06</i></p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)<br/>Paper No(s)/Mail Date. _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____</p> |
|--|--|

### **DETAILED ACTION**

1. The instant application having Application No. 10/735,876 has a total of 8 claims pending in the application; there is 1 independent claim and 7 dependent claims, all of which are ready for examination by the examiner.

#### **I. INFORMATION CONCERNING OATH/DECLARATION**

##### **Oath/Declaration**

2. The applicant's oath/declaration has been reviewed by the examiner and is found to conform to the requirements prescribed in **37 C.F.R. 1.63**.

#### **II. STATUS OF CLAIM FOR PRIORITY IN THE APPLICATION**

As required by **M.P.E.P. 201.14(c)**, acknowledgement is made of applicant's claim for priority based on applications filed on January 22, 2003 (Japan 2003-013580).

#### **III. INFORMATION CONCERNING DRAWINGS**

##### **Drawings**

3. The applicant's drawings submitted are acceptable for examination purposes.

#### **IV. ACKNOWLEDGEMENT OF REFERENCES CITED BY APPLICANT**

4. As required by **M.P.E.P. 609(C)**, the applicant's submissions of the Information Disclosure Statements dated December 16, 2003, November 22, 2005, and January 25, 2006 are acknowledged by the examiner and the cited references have been

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considered in the examination of the claims now pending. As required by **M.P.E.P 609 C(2)**, a copy of the PTOL-1449 initialed and dated by the examiner is attached to the instant office action.

## **V. REJECTIONS BASED ON PRIOR ART**

### **Claim Rejections - 35 USC § 102**

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claim 1-2 and 5-8** are rejected under 35 U.S.C. 102(b) as being anticipated by Harari et al. (US pat. 5,887,145).

7. As per **claim 1**, Harari discloses "A conversion apparatus (**removable mother card 10 in fig. 1**) connectable to an information processing apparatus (**host system 200 in fig. 1**) which is designed for a device in conformance with a first specification (**see col. 5, lines 7-15 and fig. 1**), comprising: a connecting part (**connecting part 14 in fig. 1**) having a physical shape which enables a device (**Removable daughter 20 in fig. 1**) in conformance with a second specification to be connected to the information processing apparatus (**see fig. 1**), said second specification being different from said first specification (**in col. 7, lines 54-57, Harari discloses "In the preferred embodiment, the host interface 54 communicates with the host system 200 in accordance with the PCMCIA specifications or any other standard card**

**interface”); a storage (memory interface 56 in fig. 4) to store identification information of the device in conformance with the first specification, said identification information being read from said storage in place of identification information stored within the device in conformance with the second specification and connected to the information processing apparatus, when the information processing apparatus makes access to the identification information of the device in conformance with the second specification (see col. 8, lines 10-22. Col. 12, lines 20-27 also discloses “A comprehensive controller 41 and optional functional components 42 (see also FIG. 5B) on board of the mother card 10 provide the necessary complement of components to that on the daughter card to form the complete peripheral device. This allows the daughter card to operate with any host system through the host's standard interface when a daughter card's native interface is not present”); and a voltage converter (power converter 58 in fig. 4) to convert a power supply voltage from the information processing apparatus into a converted power supply voltage in accordance with the second specification and to supply the converted power supply voltage to the device in conformance with the second specification (see col. 7, lines 57-60).**

8. As per **claim 2**, Harari discloses “The conversion apparatus as claimed in claim 1,” [See rejection to claim 1 above] “wherein the devices are portable card media” (see fig. 1)

9. As per **claim 5**, Harari discloses “wherein said storage stores at least identification information necessary to make an initial start-up within the information processing apparatus when using the device (**see col. 5, lines 37-52**).
10. As per **claim 6**, Harari discloses “wherein the identification information necessary to make the initial start-up includes power supply information (**see col. 7, lines 54-60**).
11. As per **claim 7**, Harari discloses “wherein the device in conformance with the first specification and the device in conformance with the second specification are same kind of devices (**fig. 1 shows both mother and daughter cards; both are cards, which is the same device and having different specification**).
12. As per **claim 8**, Harari discloses “wherein the device in conformance with the first specification and the device in conformance with the second specification are different kinds of devices (**fig. 1 shows the mother card having a first specification that is different from the host system, which has a different specification**).
13. **Claims 1, and 3-8** are rejected under 35 U.S.C. 102(b) as being anticipated by Kirinaka et al. (US pat. 6,052,742).
14. As per **claim 1**, Kirinaka discloses “A conversion apparatus (**conversion apparatus 11 in fig. 2**) connectable to an information processing apparatus (**device 36 in fig. 2, see col. 6, line 25-27**) which is designed for a device in conformance with a

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first specification (see col. 2, lines 5-12), comprising: a connecting part (connector 13 in fig. 2) having a physical shape which enables a device (card 21 in fig. 2) in conformance with a second specification to be connected to the information processing apparatus (see fig. 2), said second specification being different from said first specification (see col. 2, lines 5-12); a storage (ROM 33 in fig. 2) to store identification information of the device in conformance with the first specification, said identification information being read from said storage in place of identification information stored within the device in conformance with the second specification and connected to the information processing apparatus, when the information processing apparatus makes access to the identification information of the device in conformance with the second specification (col. 5, lines 25-29 discloses “The CPU 32 includes a ROM 33 where a card detection program has previously been stored. The card detection program includes a program for detecting the card insertion/detachment of the card-type expansion device 21, and a program for reading the card information”); and a voltage converter to convert a power supply voltage from the information processing apparatus into a converted power supply voltage in accordance with the second specification and to supply the converted power supply voltage to the device in conformance with the second specification (col. 6, lines 16-21 discloses “the CPU 32 reads the card information in step 46, based on the digital signal S1 from the ADC 31, which converts the analog voltage signal received from the card information holding section 24. The CPU 32 then supplies the instruction signal S2 to the card control section 15 in accordance with the read card information”).

15. As per **claims 3 and 4**, Kirinaka discloses “The conversion apparatus as claimed in claim 1,” **[See rejection to claim 1 above]** “wherein power supply voltage in accordance with the first specification is 3.3 or 5.0 V, and a power supply voltage in accordance with the second specification is 3.3 or 5.0 V **(see col. 1, lines 32-38)**).

16. As per **claim 5**, Kirinaka discloses “wherein said storage stores at least identification information necessary to make an initial start-up within the information processing apparatus when using the device **(see col. 5, lines 37-52)**).

17. As per **claim 6**, Kirinaka discloses “wherein the identification information necessary to make the initial start-up includes power supply information **(see col. 5, lines 25-46)**).

18. As per **claim 7**, Kirinaka discloses “wherein the device in conformance with the first specification and the device in conformance with the second specification are same kind of devices **(fig. 1 shows the conversion apparatus 11 and card 21 to be used together, which makes them the same kind of device. For example, one having “card information reading section” and the other having “card information holding section”)**).



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19. As per **claim 8**, Kirinaka discloses “wherein the device in conformance with the first specification and the device in conformance with the second specification are different kinds of devices (**as shown in fig. 1, it is also possible to shows the conversion apparatus 11 and card 21 to be different because the conversion apparatus 11 is not portable while the card 21 is portable**).

**Claim Rejections - 35 USC § 103**

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. **Claims 3 and 4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Harari et al. (US pat. 5,887,145) in view of Mowery et al. (US pub. 2003/0082961).

22. As per **claims 3 and 4**, Harari discloses “The conversion apparatus as claimed in claim 1,” [See rejection to claim 1 above] including “**The controller may also include other functional components such as a power converter 58 for providing the necessary voltage conditions for the various memory operations**”, as discloses in col. 7, lines 57-60, but fails to disclose expressly a first or a second voltage being 3.3 or 5v.

Mowery discloses a card voltage value to be 3.3 or 5volts (**see fig. 6B and paragraph 0034**)

Harari et al. (US pat. 5,887,145) and Mowery et al. (US pub. 2003/0082961) are analogous art because they are from the same field of endeavor of replaceable memory card.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the structures and configurations of such a card, provide a removable card that stores encoded data that can be decoded when the card is relocated from one host system to another as described by Harari and to provide a solution that enables the use of a single passive socket for multiple types of flash media cards as taught by Mowery.

The motivation for doing so would have been because Mowery teaches of selecting the appropriate voltage level to protect the card's controller from a short (**see paragraph 0034**).

Therefore, it would have been obvious to combine Harari et al. (US pat. 5,887,145) and Mowery et al. (US pub. 2003/0082961) for the benefit of creating a removable memory card to obtain the invention as specified in claims 3 and 4.

23. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirinaka et al. (US pat. 6,052,742) in view of Mowery et al. (US pub. 2003/0082961).

24. As per **claim 2**, Kirinaka discloses "The conversion apparatus as claimed in claim 1," [**See rejection to claim 1 above**] but fails to disclose expressly "wherein the devices are portable card media"

Mowery discloses the devices are portable card media (**see fig. 1**)

Kirinaka et al. (US pat. 6,052,742) and Mowery et al. (US pub. 2003/0082961) are analogous art because they are from the same field of endeavor of memory card.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the improved connection between a host machine and a card device as described by Kirinaka and to provide a solution that enables the use of a single passive socket for multiple types of flash media cards as taught by Mowery.

The motivation for doing so would have been because Mowery teaches of selecting the appropriate voltage level to protect the card's controller from a short (**see paragraph 0034**).

Therefore, it would have been obvious to combine Kirinaka et al. (US pat. 6,052,742) and Mowery et al. (US pub. 2003/0082961) for the benefit of creating a removable memory card to obtain the invention as specified in claim 2.

## **VI. RELEVANT ART CITED BY THE EXAMINER**

25. The following prior art made of record and not relied upon is cited to establish the level of skill in the applicant's art and those arts considered reasonably pertinent to applicant's disclosure. See **MPEP 707.05(c)**.

26. The following reference teaches removable memory cards.

### **U.S. PATENT NUMBER**

US 2005/0060466

US 2005/0086433

US 2005/0117553

US 2006/0015673

US 2005/0273648

US 2004/0070952

US 6,908,038

US 2005/0037647

US 6,890,188

US 2003/0154326

**VII. CLOSING COMMENTS**

**Conclusion**

**a. STATUS OF CLAIMS IN THE APPLICATION**

27. The following is a summary of the treatment and status of all claims in the application as recommended by M.P.E.P. 707.07(i):

**a(1) CLAIMS REJECTED IN THE APPLICATION**

28. Per the instant office action, claims 1-8 have received a first action on the merits and are subject of a first action non-final.

**b. DIRECTION OF FUTURE CORRESPONDENCES**

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernest Unelus whose telephone number is (571) 272-8596. The examiner can normally be reached on Monday to Friday 9:00 AM to 5:00 PM.

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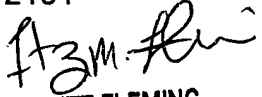
**IMPORTANT NOTE**

30. If attempts to reach the above noted Examiner by telephone is unsuccessful, the Examiner's supervisor, Mr. Fritz M. Fleming, can be reached at the following telephone number: Area Code (571) 272-4145.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 27, 2006

Ernest Unelus  
Examiner  
Art Unit 2181

  
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7/7/2006